

REMARKS/ARGUMENTS

Claims 1-17 are pending. The Office Action indicated that claims 13-15 and 17 are allowable.

The provisional double patenting rejection will be addressed at a later date.

Rejections under 35 USC § 102

The rejection of claims 1, 6-8, 10, 11 and 16 as anticipated by Kita et al. is respectfully traversed.

The Patent Office has established a standard by which prior art must be judged to satisfy anticipation. The standard is set forth in MPEP § 2131, which states in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST
TEACH EVERY ELEMENT OF THE CLAIM.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)....."The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsisimilis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claims 1, 6-8, 10, 11 and 16 call for a binaphthyl compound in which Ar¹ and Ar² are bound to the binaphthyl core at specific positions. These features are not expressly described in the Kita et al. reference. Kita et al. provide a generic formula (G2) comprising a binaphthyl core, in which each naphthyl half contains from 0 - 4 R groups, and each R group is one of twenty or more different chemical moieties. Only some of the many possible combinations of substituents read on the claimed compounds, i.e., only those combinations containing particular aromatic groups in the specific locations called for in the claims. However, none of these particular combinations is specifically identified by Kita et al. The mere fact that some unidentified combination of substituents from Kita et al.'s generic formula reads on claims 1, 6-8, 10, 11 and 16 is not sufficient as a matter of law to anticipate those claims.

"When a compound is not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990); MPEP § 2131.02. A compound is anticipated if one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula, or the compound is clearly named in the reference. MPEP § 2131.02. Neither of these conditions applies to the Kita et al reference. Nothing in the Kita et al. reference specifically indicates that two R groups are positioned at the particular locations called for in the claims, or that the two R groups are both aromatic moieties. Moreover, none of Kita et

al.'s many examples show such an arrangement of elements. Thus, the particular combination of substituents called for in the claims is neither clearly named nor "at one envisaged." The Kita et al. reference does not expressly or inherently described the particular structures called for in the claims, nor does it show "in as complete detail" the claimed structures. As such, the reference fails to satisfy the standard for anticipation. Accordingly, claims 1, 6-8, 10, 11 and 16 are not anticipated.

Rejections under 35 USC § 103

The rejection of claims 1, 3 and 9 as obvious over the Kita et al. reference is respectfully traversed.

The Patent Office has established guidelines for obviousness of a chemical species or subgenus where a single prior art reference discloses a genus encompassing the claimed species or subgenus, but does not expressly disclose the particular claimed species or subgenus. The standard is set forth in MPEP § 2144.08. As these guidelines indicate, the mere fact that a combination of substituents from a generic formula reads on a claim does not by itself render the claim obvious. Rather, to establish a *prima facie* case of obviousness, there must be some motivation in the prior art to make the particular claimed species or subgenus. MPEP § 2144.08(II)(A). In the present case, nothing in Kita et al. provides the required motivation to make the particular compounds called for in the claims.

Claims 1, 3 and 9 call for a binaphthyl compound in which Ar¹ and Ar² are bound to the binaphthyl core at specific positions. Kita et al. describe a generic formula(G2) comprising a binaphthyl core, in which each naphthyl half contains from 0 - 4 R groups, and each R group is one of twenty or more different chemical moieties. To apply the Kita et al. reference to the claims, it is necessary to chose at least one R group for each naphthyl half; locate two R groups at particular positions on the binaphthyl core, as opposed to the many other positions available on the core structure; select an aromatic group for one R group from the more than 20 available chemical moieties; and select an aromatic group for the second R group from the more than 20 chemical moieties. The choice of these particular substituents is even less obvious considering that nothing in Kita et al. points to this specific combination of elements. None of the many examples provided by Kita et al. show or suggest the type of structure called for in claims 1, 3 and 9.

Therefore, to arrive at the claimed structures, numerous possible choices would have to be tried under circumstances where Kita et al. provide no direction pointing to the particular compounds called for in the claims. With so many possible structures to choose from, and nothing to indicate the desirability of the claimed compounds, Kita et al. provide no reason or suggestion to modify their generic structure to make the particular structures called for in the claims. Indeed, deriving the claimed compounds from the teachings of Kita et al. is simply impermissible hindsight reasoning. Because there is no motivation or suggestion to make the structures called for in claims 1, 3 and 9, the claims are not obvious.

In view of the foregoing remarks, Applicants submit that the present claims are in condition for allowance. Reconsideration of the application is therefore respectfully requested.

The Commissioner is hereby authorized to charge payment of any fees required associated with this communication or credit any overpayment to Deposit Account No. 50-0337. If an extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. 50-0337. A duplicate copy of this paper is enclosed.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Miles Yamanaka", with a long horizontal stroke extending to the right.

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